

The opinion in support of the decision being entered today was **not** written for publication and
is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL KENNETH CERRETA,
PETER YAU-TAK LIN,
PENELOPE MARIE EDWARDS,
and
MARK LEWIS AGERTON

Appeal No. 2003-1787
Application No. 08/914,743

ON BRIEF

Before WILLIAM F. SMITH, TIMM, and ADAMS, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-19 and 41-54 as amended after the Final Rejection.¹

Claims 20-40 and 55, the only other claims pending in the application, have been withdrawn by the Examiner as directed to a non-elected invention. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

¹The Advisory Action mailed on February 11, 2002 indicates that the Amendment filed on January 24, 2002 (certificate of mailing dated December 13, 2001) will be entered upon the filing of an appeal. We note that the amendment has not yet been physically entered. This oversight should be remedied upon return of the Application to the jurisdiction of the Examiner.

INTRODUCTION

The claims are directed to a flowable nondigestible oil composition. Claim 41, the broadest independent claim, is illustrative of the subject matter on appeal:

41. A flowable² nondigestible oil composition comprising

a liquid polyol fatty acid polyester having a complete melt point of a [sic] less than about 37°C, and

a solid polyol fatty acid polyester having a complete melt point of at least about 37°C, wherein the solid polyol fatty acid polyester is in the form of crystallized spherulitic particles, wherein said crystallized spherulitic particles have a diameter of from about 1 microns to about 50 microns,

and wherein the flowable nondigestible oil composition has a Consistency³ in a temperature range of 20-40°C in the range of from about 0 P.sec⁽ⁿ⁻¹⁾ to about 30 P.sec⁽ⁿ⁻¹⁾.⁴

All of the pending claims, claims 1-19 and 41-54, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elsen.⁵

²According to Appellants, "flowable refers to the ability of a composition to be transported by gravity or by conventional mechanical or pneumatic pumping means from a storage vessel." (specification, p. 4, ll. 13-14).

³Consistency (K) is determined by measuring apparent viscosity during the application of increasing amounts of shear stress on the fluid. The apparent viscosity and shear rate data is used to create a flow curve which is then modeled according to the power law model: Apparent Viscosity = K (Shear Rate)ⁿ⁻¹. Consistency (K) is numerically equal to the apparent viscosity at a shear rate of 1 sec⁻¹. The values of K and n describe the flow behavior of the nondigestible oil within specific limits of shear (specification, p. 27, ll. 4-23).

⁴Paragraph indentations added.

⁵U.S. Patent 5,422,131 issued to Elsen et al. on June 6, 1995.

We reverse.

OPINION

At the outset, we note that, where as here, Appellants state that all the claims are to stand or fall together, the focus of the rejection, as presented in the Answer, should be on the broadest independent claim. In the present case, however, the Examiner focused on claim 1. Claim 1, however, is not the broadest independent claim, claim 41 is broader. While the error is not fatal, the Examiner should understand that it causes difficulties that are best avoided and indicates carelessness.

An additional problem with the statement of the rejection is its confused nature. It is difficult to tell which legal doctrine is being applied to the findings of fact. Moreover, it is logically inconsistent. The following portion of the rejection is telling in this regard:

The nondigestible composition disclosed in the instant claims differs from the nondigestible compositions disclosed in the Elsen et al reference in the recitation of the compositions having "a Consistency in a temperature range of 20-40°C in the range of from about 0 P·sec(n-1) to about 30 P·sec(n-1)", which is not recited in the Elsen et al patent. However, it is noted that all the other features of the instantly claimed nondigestible oil composition that are disclosed in instant Claim 1 that appears to directly or indirectly determine the Consistency of the nondigestible oil composition are set forth for the nondigestible fat compositions of the Elsen et al patent. For example, the Elsen et al. patent discloses a nondigestible fat composition that comprises liquid polyol fatty acid polyesters having a melting point less than 37°C, a solid polyol fatty acid polyester having a melt point about 37°C, and solid polyol fatty acid polyesters having a diameter between 1 and 50 microns, as instantly claimed. Without a side-by-side comparison between the nondigestible oil composition of the instant claims with

the nondigestible fat composition that is disclosed in the Elsen et al patent that shows patentably distinct characteristics between the compositions, there is no reason for one of ordinary skill in the art to indicate an obvious patentable difference between the compositions. Accordingly it would have been obvious to one of ordinary skill in the art having the Elsen et al patent before him to obtain the instantly claimed nondigestible composition in view of their closely related structures of the components of the compositions and the resulting expectation of similar organoleptic properties for food prepared with the nondigestible compositions.

(Answer, pp. 5-6). The above reproduced section of the statement of rejection first seems to point to a finding that the Consistency is an inherent property of the composition of Elsen. Although, instead, the Examiner articulates a somewhat different rationale indicating that “there is no reason for one of ordinary skill in the art to indicate an obvious patentable difference between the compositions.” Additionally, the ultimate conclusion is of obviousness “in view of closely related structures” and “the resulting expectation of similar organopeptic properties.”

The rejection improperly commingles inherency with obviousness. According to the law with regard to inherency, the initial burden is on the examiner to establish that there is a reason to believe claimed property is “necessarily present”, not merely probably or possibly present in the prior art composition. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977); see also *Trintec Industries Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). The examiner must provide enough evidence or scientific reasoning to establish that the belief that the property is inherent is a reasonable belief. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (Bd.

Pat. App. & Int. 1986). Here, the Examiner correctly establishes that Elsen describes a nondigestible fat composition containing the liquid and solid polyol fatty acid polyesters of the claims. But the Examiner relies upon a disclosure in the Background of Invention of Elsen stating that the particles in the composition of other prior art references tends to form large spherulitic particles, typically from about 3 to about 32 microns in size (col. 2, ll. 55-63). Elsen expressly teaches a different particle size for the particles of the inventive composition, namely particles of thickness of about 1 micron or less (col. 3, ll. 60-64). Moreover, the particles may be of shape other than spherulitic (col. 8, ll. 41-45). Even if the Examiner had correctly articulated inherency as a basis for rejection, we could not agree that the Examiner provided a reasonable basis to believe that the Consistency property flows as a natural result of following the teachings of Elsen. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). The Examiner simply did not provide enough evidence or scientific reasoning to support a reasonable belief that Consistency is an inherent property of a composition described in Elsen. This is particularly true in view of the disclosure in Appellants' specification of a particular two-stage crystallization process which results in a flowable rather than a stiffened non-flowable oil (specification, pp. 15-17). Elsen does not describe such a crystallization method.

Nor can we agree that the rejection establishes a *prima facie* case of obviousness. First, the rejection is silent as to why one of ordinary skill in the art would have modified the inventive

composition of Elsen to obtain the larger particle size discussed as prior art. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). The fact that the two disparate teachings of particle size are contained in the same reference does not eliminate the need for a showing of a reason, suggest, or motivation for the combination.

Second, the conclusion that “it would have been obvious to one of ordinary skill in the art having the Elsen et al patent before him to obtain the instantly claimed nondigestible composition in view of their closely related structures of the components of the composition and the resulting expectation of similar organoleptic properties for food prepared with the nondigestible compositions” (Answer, pp. 5-6) is confusing in view of the finding that Elsen teaches both the liquid and solid polyol fatty acid polyesters (Answer, p. 5). The Examiner has found the chemical structure to be the same, therefore, there would seem to be no reason to resort to a conclusion of obviousness based on “closely related structures.” If the “closely related structures” referred to are the particle sizes, we cannot agree that Elsen provides a reason, suggestion or motivation to use the larger 3-32 micron particle size of the prior art as Elsen specifically teaches that there are problems of separation at that particle size and teaches, instead, a process of obtaining a smaller particle size of less than about 1 micron.

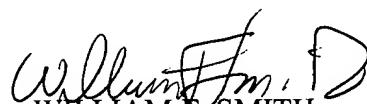
The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability.

In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of claims 1-19 and 41-54.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-19 and 41-54 under 35 U.S.C. § 103(a) is reversed.

REVERSED


WILLIAM F. SMITH
Administrative Patent Judge

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CATHERINE TIMM
Administrative Patent Judge

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DONALD E. ADAMS
Administrative Patent Judge

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224